

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL A. JOHNSON and JON M. PENNYCOOK

Appeal No. 1998-3322
Application No. 08/796,500

HEARD: June 13, 2001

Before GARRIS, WALTZ, and JEFFREY SMITH, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 21-35 which are all of the claims remaining in the application.

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The subject matter on appeal relates to a thermosettable pressure sensitive adhesive composition and to a method of bonding a component to a surface using such a composition. The composition includes a polymerization product, an epoxy resin and a pigment wherein these ingredients and the amounts thereof are selected such that the composition is capable of undergoing a detectable color change upon reaching a pre-determined level of cure. This appealed subject matter is adequately illustrated by independent claims 21 (the method) and 35 (the composition), and a copy of these claims taken from the appellants' brief is appended to this decision.

The references relied upon by the examiner as evidence of obviousness are:

Ryan 1964	3,131,251	Apr. 28,
Gaussens et al. (Gaussens)	4,230,766	Oct. 28, 1980
Brenner	4,483,951	Nov. 20, 1984
Green	4,552,604	Nov. 12, 1985
Urban et al. (Urban)	4,717,605	Jan. 5, 1988
Kitano et al. (Kitano)	5,086,088	Feb. 4, 1992

Claims 21-35 stand rejected under the first paragraph of 35 U.S.C. § 112 as being based upon a disclosure which fails to satisfy the written description requirement of this paragraph for the now claimed subject matter.

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In addition, the examiner has made the following rejections under 35 U.S.C. § 103: Claim 35 is rejected over Kitano in view of Urban and Brenner; claims 21-26, 28-32, 34 and 35 are rejected over Green in view of Urban and Brenner; claim 27 is rejected over Green in view of Urban, Brenner and Gaussens; and claim 33 is rejected over Ryan in view of Green, Urban and Brenner.

We refer to the brief and reply brief and to the answer for a complete discussion of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejections.

OPINION

We cannot sustain any of the rejections advanced by the examiner on this appeal.

The examiner's section 112, first paragraph, rejection is based upon his belief that the appellants' specification does not contain written description support for "the limitation in the claims . . . requiring the selection of ALL of the adhesive components . . . to be responsible for the color change which occurs in the adhesive upon curing thereof" and that the specification fails to establish "a phase separation

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between the epoxy and acrylate polymers, but rather ONLY SOME unspecified phase separation involving the epoxy polymer component" (answer, pages 7-8; emphasis in original).

However, we do not perceive the appealed claims as being limited in these respects. For example, neither of the independent claims on appeal recites that all of the adhesive components are responsible for the color change or that a phase separation occurs between certain components. In our view, none of the concerns expressed by the examiner in the answer support his conclusion that the now claimed invention includes "new matter" (answer, page 8). It follows that we cannot sustain the examiner's section 112, first paragraph, rejection of the claims on appeal.

We also cannot sustain any of the examiner's section 103 rejections. As correctly indicated by the appellants in their brief and reply brief, the references applied in these rejections, while evincing that it was known in the prior art to use the here claimed ingredients such as pigments in adhesive compositions of the type under consideration, contain no teaching or suggestion of combining the appellants' claimed ingredients in such relative amounts that a detectable color

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change occurs at a pre-determined level of cure as required by each of the independent claims on appeal. Concerning this issue, the examiner urges that combining the ingredients in the amounts taught by the applied references would have yielded a composition that "would apparently effect a color change therein upon cure thereof" (answer, page 10). However, the examiner has advanced no evidentiary support (and we perceive none independently) for the proposition that an adhesive composition taught or suggested by the applied prior art would necessarily or inherently undergo a detectable color change upon reaching a pre-determined level of cure as claimed by the appellants. Thus, we are constrained to conclude that the examiner's aforequoted position must be based upon conjecture, speculation or assumption. It is appropriate, therefore, to remind the examiner that a rejection under 35 U.S.C. § 103 must rest on a factual basis rather than conjecture, speculation or assumption. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

In summary, none of the rejections before us on this appeal can be sustained.

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The decision of the examiner is reversed.

REVERSED

	Bradley R. Garris)	
	Administrative Patent Judge)	
)	
)	
)	
	Thomas A. Waltz)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	Jeffrey T. Smith)	
	Administrative Patent Judge)	

BRG:tdl

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APPENDIX

21. A method of bonding a component to a surface comprising the steps of:

(a) disposing a thermosettable pressure sensitive adhesive composition between said component and said surface,

said pressure sensitive adhesive composition comprising

(i) the polymerization product of a monomeric or partially polymerized composition comprising at least one polymerizable acrylic or methacrylic acid ester of a non-tertiary alcohol;

(ii) a thermosettable epoxy resin; and

(iii) a pigment,

said polymerization product, said epoxy resin, said pigment, and the relative amounts thereof, being selected such that said pressure sensitive adhesive composition undergoes a detectable color change upon reaching a pre-determined level of cure; and

(b) curing said pressure sensitive adhesive composition until said composition undergoes a detectable color change to form a thermoset adhesive bonding said component to said surface.

35. A thermosettable pressure sensitive adhesive composition comprising:

(i) the polymerization product of a monomeric or partially polymerized composition comprising at least one polymerizable acrylic or methacrylic acid ester of a non-tertiary alcohol;

(ii) a thermosettable epoxy resin; and

(iii) a pigment,

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said polymerization product, said epoxy resin, and said pigment, and the relative amounts thereof, being selected such that said pressure sensitive adhesive composition is capable of undergoing a detectable color change upon reaching a pre-determined level of cure.